

Please add the following new claims:

52. (New) The method of Claim 1, the subsequent vendor distinct from the initial vendor.

53. (New) The method of Claim 1, the initial vendor comprising a grocery store and the subsequent vendor comprising a gas station.

C10 54. (New) The method of Claim 1, the pre-determined redeemable item comprising fuel.

55. (New) The system of Claim 25, the subsequent vendor distinct from the initial vendor.

56. (New) The system of Claim 25, the initial vendor comprising a grocery store and the subsequent vendor comprising a gas station.

57. (New) The system of Claim 25, the pre-determined redeemable item comprising fuel.

REMARKS

This Application has been carefully reviewed in light of the Office Action mailed August 11, 2000. In the Office Action, the Examiner rejected Claims 1-51. In order to advance prosecution of this application, Claims 1, 6, 23-25, 45-47 and 51 are amended and Claims 52-57 are added. Thus, Claims 1-57 are now pending in this Application. Applicants respectfully request reconsideration and favorable action in this case.

Section 102 Rejections

The Examiner rejected pending Claims 1-3, 7, 14-21, 23, 25-27, 31, 36-43, 45 and 47-50 under 35 U.S.C. §102(b) as being unpatentable over European Patent No. 0 511 463 A2 issued to Greer (*Greer*). Of these, Claims 1 and 25 are independent. Applicants respectfully traverse these rejections for the reasons discussed below.

Applicants respectfully submit that *Greer* fails to disclose, teach or suggest “identifying discount triggering items in an initial purchase transaction at an initial vendor, the discount triggering items associated with a pre-determined redeemable item,” and “generating the redemption value for the pre-determined redeemable item based on the bundle totals, the redemption value representing a discount available for use in a subsequent purchase transaction at a subsequent vendor, the subsequent purchase transaction comprising the pre-determined redeemable item,” as recited by amended Claim 1.

Greer is directed toward a method for “generating, in a retail store, a printable cumulative discount certificate . . . redeemable on a subsequent visit to the store.” Col. 2, lines 23-28. As such, *Greer* provides for applying a discount generated at a first visit to the store to a customer's order during a subsequent visit to the store. Col. 8, lines 22-36. Thus, *Greer* fails to disclose that the discount is to be applied to a pre-determined redeemable item, but appears to teach that the discount may be applied to any customer order on a subsequent visit. Therefore, *Greer* only provides incentives to purchase triggering products from the store and to return to the same store, thereby providing a benefit only to the store and to the manufacturers of the triggering products. Col. 9, lines 1-28.

In contrast, the present invention provides for discount triggering items to be associated with a pre-determined redeemable item. As such, the present invention results in a customer's being given incentive (i) to purchase the discount triggering items (ii) from the initial vendor and (iii) to purchase the pre-determined redeemable item (iv) from the subsequent vendor. Thus, both the initial vendor and the subsequent vendor benefit, as well as the manufacturers of both the discount triggering items and the pre-determined redeemable item. Therefore, *Greer* fails to teach all elements of amended Claim 1. Accordingly, Claim 1, as amended, is not anticipated by the cited art. Therefore, Applicants respectfully submit that this rejection should now be withdrawn.

Similarly, independent Claim 25, as amended, recites “identifying means for identifying discount triggering items in an initial purchase transaction at an initial vendor, the discount triggering items associated with a pre-determined redeemable item,” and “output means for generating the redemption value for the pre-determined redeemable item based on the bundle totals, the redemption value representing a discount available for use in a subsequent purchase transaction at a subsequent vendor, the subsequent purchase transaction comprising the pre-determined redeemable item.” Accordingly, for the reasons discussed above in connection with Claim 1, Claim 25, as amended, is also not anticipated by the cited art. Therefore, Applicants respectfully submit that this rejection should now be withdrawn.

Dependent Claims 2, 3, 7, 14-21, 23, 47 and 48 that depend from independent Claim 1 and dependent Claims 26, 27, 31, 36-43, 45, 49 and 50 that depend from independent Claim 25 are also not anticipated by the cited art because they include the limitations of their respective base claims and add additional elements that further distinguish the art. Therefore, Applicants respectfully submit that these rejections should now be withdrawn.

Section 103 Rejections

The Examiner rejected pending Claims 4-6, 8-13, 22, 24, 28-30, 32-35, 44, 46 and 51 under 35 U.S.C. §103(a). Claims 22, 44 and 51 were rejected as being unpatentable over *Greer*. Claims 4, 5, 28 and 29 were rejected as being unpatentable over *Greer* in view of U.S. Patent No. 5,612,868 issued to Off, et al. (*Off*). Claims 6 and 30 were rejected as being unpatentable over *Greer* in view of U.S. Patent No. 4,723,212 issued to Mindrum, et al. (*Mindrum*). Claims 8, 9, 32 and 33 were rejected as being unpatentable over *Greer* in view of U.S. Patent No. 5,481,094 issued to Suda (*Suda*). Claims 10-13, 24, 34, 35 and 46 were rejected as being unpatentable over *Greer* in view of U.S. Patent No. 5,380,991 issued to Valencia, et al. (*Valencia*). Of these, Claim 51 is independent. Applicants respectfully traverse these rejections for the reasons discussed below.

Claims 4-6, 8-13, 22 and 24 depend from independent Claim 1, and Claims 28-30, 32-35, 44 and 46 depend from independent Claim 25. As discussed above in connection with the § 102 rejections, Claims 1 and 25 are patentable over the cited art. Therefore, Claims 4-6, 8-13, 22, 24, 28-30, 32-35, 44 and 46 are patentable over the art because they include the elements of their

respective base claims and add additional elements that further distinguish the art. Accordingly, Applicant respectfully submits that these rejections should now be withdrawn.

Independent Claim 51, as amended, recites “identifying credit triggering items in an initial purchase transaction at an initial vendor, the discount triggering items associated with a pre-determined redeemable item” and “generating the redemption value for the pre-determined redeemable item based on the bundle totals, the redemption value representing a credit available for use in a subsequent purchase transaction at a subsequent vendor, the subsequent purchase transaction comprising the pre-determined redeemable item.” Accordingly, for the reasons discussed above in connection with Claim 1, Claim 51 is patentable over the cited art. Therefore, Applicants respectfully submit that this rejection should now be withdrawn.

New Claims

Claims 52-57 have been added to more fully claim the present invention. Applicants respectfully submit that no new matter is added by these claims. Claims 52-54 depend from independent Claim 1 and Claims 55-57 depend from independent Claim 25. Thus, Claims 52-57 are patentable over the cited art because they include the limitations of their respective base claims and add additional elements that further distinguish the art. Therefore, Applicants respectfully request allowance of Claims 52-57.

In particular, Claims 52 and 55 each recite “the subsequent vendor distinct from the initial vendor,” which is patentable over *Greer*, as *Greer* discloses a method “for automatically generating, in a retail store, a printable cumulative discount certificate that includes discounts for multiple products purchased in a single order, the certificate being redeemable on a subsequent visit to the store.” Col. 2, lines 23-28 (emphasis added). *Greer* fails to disclose any type of certificate or coupon which is generated at one vendor to be redeemed at another vendor. In fact, *Greer* discloses that an advantage of its system is that “large numbers of customers are involved and given incentive to return to the store.” Col. 9, lines 17-19 (emphasis added). Thus, *Greer* cannot be modified to include the elements of Claims 52 and 55 as any such modification would destroy the functionality of the system by eliminating the advantage of providing a customer incentive to return to the same store to redeem the certificate. Thus, for this reason also, Claims 52 and 55 are allowable.

Similarly, Claims 53 and 56 each recite "the initial vendor comprising a grocery store and the subsequent vendor comprising a gas station." As described above in connection with Claims 52 and 55, *Greer* fails to disclose any type of certificate or coupon which is generated at one vendor to be redeemed at another vendor. Thus, *Greer* necessarily also fails to disclose generating a certificate at a grocery store for redemption at a gas station. Thus, for this reason also, Claims 53 and 56 are allowable.

Claims 54 and 57 each recite "the pre-determined redeemable item comprising fuel." As discussed above in connection with Claim 1, *Greer* fails to disclose a redemption value associated with a pre-determined redeemable item. Thus, *Greer* necessarily also fails to disclose generating a certificate representative of a discount available for use in a subsequent purchase of fuel. Thus, for this reason also, Claims 54 and 57 are allowable.

CONCLUSION

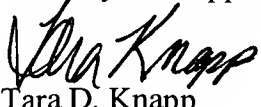
Applicants have now made an earnest attempt to place this case in condition for allowance. For the foregoing reasons, and for other reasons clearly apparent, Applicants respectfully request full allowance of all pending Claims.

If the Examiner feels that a telephone conference would advance prosecution of this Application in any manner, the undersigned attorney for Applicants stands ready to conduct such a conference at the convenience of the Examiner.

The Commissioner is hereby authorized to charge any fees or credit any overpayments to Deposit Account No. 02-0384 of Baker Botts L.L.P.

Respectfully submitted,

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